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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

RE APPLICATION OF:

TETSURO MOTOYAMA : EXAMINER: HO, C.

SERIAL NO: 09/192,583 :

FILED: NOVEMBER 17, 1998 : GROUP ART UNIT: 2153

FOR: METHOD AND SYSTEM FOR  
COMMUNICATING WITH A  
DEVICE ATTACHED TO A COMPUTER  
USING ELECTRONIC MAIL  
MESSAGES

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APPEAL BRIEF

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

This appeal is responsive to the Final Office Action mailed July 5, 2001.

**I. REAL PARTY IN INTEREST**

The real party in interest for this application are the assignees, Ricoh Company, Ltd. and Ricoh Corporation.

**II. RELATED APPEALS AND INTERFERENCES**

The inventor of the present application currently has on appeal Serial Nos. 08/738,659, and 08/738,461. Even though it is presently believed that a decision in these applications will not directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal, these applications are disclosed merely as a precaution to assure that full disclosure is made to the PTO. There are no other applications on appeal

which are related to or will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal

### **III. STATUS OF CLAIMS**

Each of pending Claims 1-53 stands rejected, and there are no canceled or allowed claims in the present application.

### **IV. STATUS OF AMENDMENTS**

No amendment has been filed since the final rejection mailed July 5, 2001. Therefore, all amendments that have been filed in this application have been entered.

### **V. SUMMARY OF INVENTION**

A first aspect of the invention (e.g., Group I) relates to determining whether an electronic mail message which has been received is for a device which is associated with a computer. One embodiment of the invention providing support for Claim 1 and the invention of Group I is shown in Figure 14 and described in the specification at p. 26, line 22 - p. 28, line 10. A feature of the present invention is determining if the e-mail which is received is for a user or an attached device. Such a feature is shown, for example, in step 526 of Figure 14, and explained in the specification at least at p. 27, line 18 - p. 28, line 10.

The invention of Group II includes determining whether the message which has been received is for the device or whether the message which has been received is for the user. As seen in the embodiment of Figure 14, step 528 is performed when the e-mail is for the attached device, and step 530 is performed when the e-mail is for the user. Such steps are also described at p. 27, line 18 - p. 28, line 10, for example.

Another feature of the invention, included in Group III, is that the recited business office device at least one of generates an image on a recording medium and scans an image on a recording medium. Such a feature includes copiers, printers, scanners, fax machines, and other business office devices, and is supported by the printer, facsimile machine, and copier illustrated at the top of Figure 1, for example, and described at page 7 of the specification.

A further feature of the invention is the use of a device driver. An exemplary device driver 440 is illustrated in Figure 9 and described in the specification at p. 22, line 17 - p. 23, line 14. It is acknowledged that the specification generally explains that if desired, the invention may be implemented without using a device driver. See p. 26, lines 12-17. However, the invention of Group IV specifically recites and is limited to the use of a device driver which is a special type of software and does not include every type of software.

## VI. ISSUES

The issues being appealed are as follows:

- (1) Whether Claims 1, 2, 3, 8, 12-17, 20, 23-25, 34-39, 42, 45, 46, and 50-52 are unpatentable under 35 U.S.C. §103 as being unpatentable over Kuwabara (U.S.P. 6,065,136) in view of McCormick et al (U.S.P. 6,023,723);
- (2) Whether Claims 4-7, and 26-31 are unpatentable under 35 U.S.C. §103 over Kuwabara and McCormick et al in view of Frantz (U.S.P. 6,073,166);
- (3) Whether Claims 10, 11, 21, 22, 32, 33, 43, 44, 47, 49, and 53 are unpatentable under 35 U.S.C. §103 over Kuwabara and McCormick et al in view of Miyachi (U.S.P. 6,108,492); and
- (4) Whether Claims 18 and 40 are anticipated under 35 USC 102 by Frantz.

## **VII. GROUPING OF CLAIMS**

<b>GROUP</b>	<b>CLAIMS</b>
Group I	Claims 1, 23, and all claims depending from Claims 1 and 23.
Group II	Claims 2 and 24
Group III	Claim 47
Group IV	Claims 18, 40, and all claims depending therefrom, and Claims 9 and 31.
Group V	Claims 49 and 53

The only claims which stand or fall together are the claims within each group.

Separate arguments are presented explaining the patentability of the claims in each group.

## **VIII. ARGUMENT**

### **Arguments for Group I**

The invention of Group I includes independent Claims 1 and 23, and all claims depending therefrom. Taking Claim 1 as an example, there is recited a step of determining whether an electronic mail message which has been received by a computer is for a device associated with the computer by detecting a characteristic of the e-mail. The outstanding Office Action has rejected Claim 1 utilizing the combination of Kuwabara in view of McCormick et al. The Office Action acknowledges at the top of page 3 that Kuwabara does not disclose the step of determining whether the message which has been received is for a device. However, the Office Action states that the feature of determining whether the message which has been received is for a device is disclosed by the filtering aspect of

McCormick et al. It is respectfully asserted that whether or not an electronic mail message is filtered is not the same as determining whether the message is for a device.

In a scheme of filtering e-mails, as disclosed in McCormick et al, every e-mail addressed to a user is "for" the user. If anyone were to look at the e-mail, they would know that the e-mail was "for" the addressee, but the filtering controlled whether or not the e-mail which was for the user was delivered. Stopping e-mail from being delivered (e.g., filtering) is not determining whether the message is for the user, but is a step of determining whether the user would want to receive the e-mail. Thus, it is evident that there is not disclosed in McCormick et al the determination of whether the message which has been received is for a device, as claimed.

As another example, the junk mail I receive at my house is for me. I may discard this junk mail before I open and read it, but nevertheless, somebody looking at the junk mail in my trash can would say that the junk mail is for me. Such an example further bolsters the conclusion that an email filtering program does not determine if an email is for the device, as claimed.

Therefore, the invention of Group I, including independent Claims 1 and 23 and each of the claims depending therefrom is patentable, and the rejection using Kuwabara in view of McCormick et al should be reversed.

### **Arguments for Group II**

Group II which includes Claims 2 and 24, for example, recites a determining of whether the message has been received is for the device, or whether the message which has been received has a user of the computer as an end recipient. The outstanding Office Action refers to Kuwabara for this determining step. However, with respect to Claim 1, the

Examiner has acknowledged that Kuwabara does not disclose determining whether the message is for a device associated with the computer. Moreover, there is no determination in Kuwabara as to whether the message which has been received has a user of the computer as an end recipient. The outstanding Office Action references column 5, line 65 - column 6, line 22 of Kuwabara. However, this portion of Kuwabara only discloses that a program for trouble inspecting may be sent to user A, but nowhere is it disclosed or suggested that there is a determining of whether the message which has been received is for the user A. If the user A receives the e-mail, then the e-mail is for the user A, and there is no determining step performed, as recited in the claim. Therefore, even if McCormick et al and Kuwabara could be combined, there is no step of determining, as recited in Claim 2, and therefore, the rejection must be reversed.

Moreover, the Examiner has not provided any motivation for taking a portion of the determining step from Kuwabara, and another portion of the determining step from McCormick et al, and combining such separate teachings into the determining step as recited in Claim 2, for example. Without such motivation, the rejection of Claim 2 must be reversed. The Examiner is not permitted to pick and choose different elements from different references and combine such different elements into the claimed combination without proper motivation. No such motivation has been provided.

Therefore, the rejection of each of the claims of Group II should be reversed.

### **Arguments for Group III**

Claim 47 requires the business office device to at least one of generate an image on a recording medium, and scan an image on a recording medium. The outstanding Office Action has rejected claims reciting the specific features of the business office device using

the combination of Kuwabara and McCormick et al, and further in view of Miyachi. With regard to independent Claim 1, the Office Action refers to the computer of McCormick et al as being the claimed business office device. The office action has the computer of McCormick et al which receives an email being substituted for the business office device disclosed in Miyachi. This makes no sense as who would ever substitute a general purpose computer which receives emails with a printing or scanning device? McCormick et al simply discloses an e-mail filtering system, and all of a sudden, this e-mail filtering system is now having e-mails being transmitted to a printing or scanning device. There is no motivation or suggestion within any of the prior art for modifying the end recipient of the filtering system of McCormick et al to be a device which prints or scans. Yet this is exactly what the combination set forth by the Examiner is doing; substituting a printer for a recipient of e-mail, without any motivation to do so.

Therefore, the rejection of the claims of Group III is erroneous and must be reversed.

#### **Arguments for Group IV**

Group IV, which includes Claims 18 and 40, for example, requires the use of a device driver. However, no prior art discloses or suggests the use of a device driver.

With regard to Claims 18 and 40, the Examiner has indicated that column 4, lines 44-50 and column 5, lines 1-67 of Frantz discloses a device driver. At column 4, lines 44-50, there is described an interpreter. At column 5, lines 1-67, there is generally disclosed the functions which are performed. However, nowhere in Frantz is there disclosed a device driver. A device driver is a known term of art and includes software that converts general input/output instructions of the operating system to messages that the device type can understand. As a device driver is a well-known term of art and has been included, for

example, in the Windows operating systems for quite some time now, the Examiner cannot ignore the meaning of device driver.<sup>1</sup> A device driver is not any and every type of software, but special software, as described above, for example. The use of a device driver is not disclosed in Frantz, or in any other prior art used by the Examiner. For example, the Examiner in paragraph 25 of the outstanding Office Action states that with regard to the device driver of Claim 9, Kuwabara discloses a device driver, and refers to Figure 1, Figure 2, column 2, lines 29-31, column 5, lines 65-67, and column 6, lines 1-22. However, a review of Kuwabara, including the specifically identified sections does not disclose a device driver, as this term is described in the art. If the Examiner disagrees with the industry standard definition of device driver and is interpreting a device driver to mean something else, then the Examiner's interpretation is requested.

#### Arguments for Group V

Group V includes Claims 49 and 53, and relates to a business office device generating an image on a recording medium or scanning an image on a recording medium, and includes the device driver limitations of Claim 18, or 40, for example. The outstanding Office Action has rejected Claim 47, for example, using the combination of Kuwabara, McCormick et al., and Miyachi. However, none of these references discloses a device driver, and the Examiner has not alleged that they disclose a device driver. Moreover, the claims recite the business office device having specific features. The specific features such as scanning or printing make the claims patentable for the same reasons the claims of Group III are patentable.

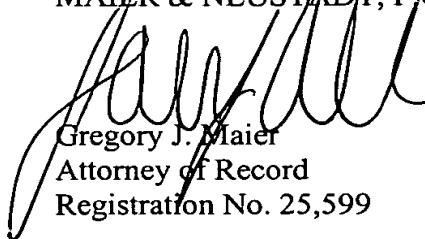
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<sup>1</sup> The mention of Windows, merely as an example, should not be considered as limiting the present invention to the Windows environment.

Based on the above arguments, the rejections of each of the claims should be reversed, and the present application passed to issuance.

Respectfully submitted,

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## APPENDIX

1. A method of processing messages, comprising the steps of:  
receiving an electronic mail message by a computer;  
determining whether the message which has been received is for a device associated with the computer by detecting a characteristic of the email, the device being a business office device including a processor;  
transmitting a communication from the computer to the device, in response to the step of determining determines that the message is for the device; and  
operating the processor of the device in response to the communication.
2. A method according to claim 1, wherein the determining step comprises:  
determining whether the message which has been received is for the device or whether the message which has been received has been received has a user of the computer as an end recipient.
3. A method according to claim 1, further comprising the step of:  
displaying, after the receiving step, a message to the user indicating the electronic mail message contains information to be forwarded to the device,  
wherein the determining step comprises:  
determining, by a user reading the message which has been displayed, whether the message which has been received is for the device.
4. A method according to claim 3, further comprising the step of:  
executing a command which causes the step of transmitting to be performed.
5. A method according to claim 4, wherein the executing step comprises:

executing program code of a file which is attached to the message by a manual action by the user.

6. A method according to claim 5, wherein the executing step comprises: executing the program code of the file by pointing, using a pointing device and a graphical user interface, to an object representing the file.
7. A method according to claim 6, wherein the executing step comprises: executing the code by pressing a button while pointing to the object representing the file.
8. A method according to claim 1, wherein the receiving step comprises: receiving an Internet electronic mail message.
9. A method according to claim 4, wherein:  
the step of executing a command comprises transmitting information to a device driver executing within the computer; and  
the step of transmitting is performed using the device driver.
10. A method according to claim 1, further comprising the steps of:  
receiving, by the device, the communication transmitted from the computer; and  
transmitting parameters from the device to the computer, in response to the communication which has been received by the device.
11. A method according to claim 10, further comprising the step of:  
performing a mechanical action by the device, in response to the communication which has been received by the device.
12. A method according to claim 1, wherein the determining step comprises:  
determining that the message is for a device automatically by detecting a characteristic of the email.

13. A method according to claim 12, wherein the determining step comprises: determining that the message is for a device automatically by detecting a code within the message.

14. A method according to claim 13, wherein the determining step comprises: determining that the message is for a device automatically by detecting the code which is the subject of the message.

15. A method according to claim 13, wherein the determining step comprises: determining that the message is for a device automatically by detecting the code which is in a body of the message.

16. A method according to claim 12, wherein the determining step is performed in response to a receipt of an incoming electronic mail message.

17. A method according to claim 16, wherein the determining step is performed in response to a receipt of an incoming electronic mail message which is detected by monitoring an existence of a file stored at a predetermined location in memory.

18. A method of transmitting, comprising the steps of:  
transmitting information from a device to a computer associated with the device, the device being a business office device including a processor;  
processing the information by a device driver within the computer; and  
transmitting, by the computer, an electronic mail message corresponding to the information.

19. A method according to claim 18, further comprising the step of:  
transmitting the information from the device driver to a messaging application programming interface (MAPI) of the computer; and  
processing the information by the MAPI,

wherein the step of transmitting the electronic mail message comprises transmitting the electronic mail message corresponding to the information which has been processed by the MAPI.

20. A method according to claim 18, wherein:

the computer is a message transfer agent,

the step of transmitting information from the device transmits the information from the device directly to the computer which is the message transfer agent, and

the step of transmitting the electronic mail message transmits the electronic mail message using a TCP connection from the computer which is a message transfer agent.

21. A method according to claim 18, wherein the processing step comprises:

creating a file corresponding to the information; and

writing the file to a mail spool directory of the computer, and

wherein the step of transmitting the electronic mail message comprises transmitting the electronic mail message corresponding to the information using the file stored in the mail spool directory.

22. A method according to claim 21, wherein:

the step of creating and writing comprises creating a plurality of files and writing the plurality of files in the mail spool directory; and

the step of transmitting comprises transmitting the electronic mail message using each of the plurality of files stored in the mail spool directory.

23. A system for processing messages, comprising:

means, associated with a computer, for receiving an electronic mail message;

means for determining whether the message which has been received is for a device associated with the computer by detecting a characteristic of the email, the device being a business office device including a processor;

means for transmitting a communication from the computer to the device, in response to the means for determining determines that the message is for the device; and

means for operating the processor of the device in response to the communication.

24. A system according to claim 23, wherein the means for determining comprises:

means for determining whether the message which has been received is for the device or whether the message which has been received has been received has a user of the computer as an end recipient.

25. A system according to claim 23, further comprising:

means for displaying a message to the user indicating the electronic mail message contains information to be forwarded to the device,

wherein the means for determining comprises:

means for determining, by a user reading the message which has been displayed, whether the message which has been received is for the device.

26. A system according to claim 25, further comprising:

means for executing a command which causes the means for transmitting to operate.

27. A system according to claim 26, wherein the means for executing comprises:

means for executing program code of a file which is attached to the message by a manual action by the user.

28. A system according to claim 27, wherein the means for executing comprises:

means for executing the program code of the file by pointing, using a pointing device and a graphical user interface, to an object representing the file.

29. A system according to claim 28, wherein the means for executing comprises:  
means for executing the code by pressing a button while pointing to the object  
representing the file.

30. A system according to claim 23, wherein the means for receiving comprises:  
means for receiving an Internet electronic mail message.

31. A system according to claim 26, wherein:  
the means for executing a command comprises means for transmitting information to  
a device driver executing within the computer; and  
the means for transmitting operates using the device driver.

32. A system according to claim 23, further comprising:  
means for receiving, by the device, the communication transmitted from the  
computer; and  
means for transmitting parameters from the device to the computer, in response to the  
communication which has been received by the device.

33. A system according to claim 32, further comprising:  
means for performing a mechanical action by the device, in response to the  
communication which has been received by the device.

34. A system according to claim 23, wherein the means for determining comprises:  
means for determining that the message is for a device automatically by detecting a  
characteristic of the email.

35. A system according to claim 34, wherein the means for determining comprises:  
means for determining that the message is for a device automatically by detecting a  
code within the message.

36. A system according to claim 35, wherein the means for determining comprising:

means for determining that the message is for a device automatically by detecting the code which is the subject of the message.

37. A system according to claim 35, wherein the means for determining comprises: means for determining that the message is for a device automatically by detecting the code which is in a body of the message.

38. A system according to claim 35, wherein the means for determining operates in response to a receipt of an incoming electronic mail message.

39. A system according to claim 38, wherein the means for determining operates in response to a receipt of an incoming electronic mail message which is detected by monitoring an existence of a file stored at a predetermined location in memory.

40. A system of transmitting, comprising the steps of:

means for transmitting information from a device to a computer associated with the device, the device being a business office device;  
means for processing the information by a device driver within the computer; and  
means for transmitting, by the computer, an electronic mail message corresponding to the information.

41. A system according to claim 40, further comprising:

means for transmitting the information from the device driver to a messaging application programming interface (MAPI) of the computer; and  
means for processing the information by the MAPI,  
wherein the means for transmitting the electronic mail message comprises means for transmitting the electronic mail message corresponding to the information which has been processed by the MAPI.

42. A system according to claim 40, wherein:

the computer is a message transfer agent,

the means for transmitting information from the device transmits the information from the device directly to the computer which is the message transfer agent, and

the means for transmitting the electronic mail message transmits the electronic mail message using a TCP connection from the computer which is a message transfer agent.

43. A system according to claim 40, wherein the means for processing comprises:

means for creating a file corresponding to the information; and

means for writing the file to a mail spool directory of the computer, and

wherein the means for transmitting the electronic mail message comprises means for transmitting the electronic mail message corresponding to the information using the file stored in the mail spool directory.

44. A system according to claim 43, wherein:

the means for creating and writing comprises means for creating a plurality of files and writing the plurality of files in the mail spool directory; and

the means for transmitting comprises means for transmitting the electronic mail message using each of the plurality of files stored in the mail spool directory.

45. A method according to claim 1, further comprising the steps of:

receiving data from the device, in response to the step of operating the processor;

creating an electronic mail message by the computer including the data which has been received; and

transmitting over the Internet the electronic mail message generated by the computer.

46. A method according to claim 1, further comprising the step of:

executing, by a device driver of the computer, commands for at least one of controlling and monitoring the device.

47. A method according to claim 1, wherein the business office device at least one of generates an image on a recording medium and scans an image on a recording medium.

48. A method according to claim 1, wherein the transmitting step comprises: transmitting the communication as a command for processing by the processor of the device.

49. A method according to claim 18, wherein the step of transmitting information from a device comprises:

transmitting the information from a business office device which at least one of generates an image on a recording medium and scans an image on a recording medium.

50. A system according to claim 23, further comprising:  
means for receiving data from the device, in response to an operation of the means for operating the processor;  
means for creating an electronic mail message by the computer including the data which has been received; and  
means for transmitting over the Internet the electronic mail message generated by the computer.

51. A system according to claim 23, further comprising:  
means for executing, by a device driver of the computer, commands for at least one of controlling and monitoring the device.

52. A system according to claim 23, wherein the means for transmitting comprises:  
means for transmitting the communication as a command for processing by the processor of the device.

53. A system according to claim 40, wherein the means for transmitting information from a device comprises:

means for transmitting the information from a business office device which at least one of generates an image on a recording medium and scans an image on a recording medium.

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